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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,935	08/31/2001	Brigitte Bathe	32301WD216	8953

7590 01/13/2005

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EXAMINER

KERR, KATHLEEN M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,935

Applicant(s)

BATHE ET AL.

Examiner

Kathleen M Kerr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,9,12-39 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 13-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,9,12,31,35,36,38,39 and 44 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 32-34 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. A request for continued examination under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. § 1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant's submission filed on October 19, 2004 has been entered.

Application Status

2. In response to the previous Office action on the merits, a Final rejection (mailed on July 1, 2004), Applicants filed an after final received on September 22, 2004. Said after-final was not entered (see Advisory Action mailed September 29, 2004). Upon the filing of an RCE (see above), said amendment was entered. Said amendment cancelled Claims 4 and 40-43, amended Claims 35-39 and 44. Thus, Claims 5, 9, 12-39 and 44 are pending in the instant Office action.

Election/Rejoinder

3. Claims 5, 9, 12-39 and 44 are pending in the instant Office action. Claims 13-30 remain withdrawn from consideration as non-elected inventions. Claims 5, 9, 12, 31-39 and 44 will be examined herein.

The restriction requirement of record (see paper mailed June 4, 2003) restricted the product claims, examined herein, and two distinct methods of using said products. Applicant is reminded that where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that **depend from or otherwise include all the limitations of the allowable product claim** will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Process claims that depend from or otherwise include all

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the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. § 1.116; amendments submitted after allowance are governed by 37 C.F.R. § 1.312. Thus, the Examiner suggests amendment of Claims 13 and/or 29 are rejoinder is to be sought.

Priority

4. As previously noted, the instant application is granted the benefit of priority for the foreign applications 100 43 337.5 and 101 36 984.0 filed in Germany on September 2, 2000 and July 28, 2001, respectively as requested in the declaration. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file. Translations of said priority documents have been received.

Withdrawn - Claim Objections

5. Previous objection to Claim 4 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is withdrawn by virtue of Applicant's cancellation of said claim.

6. Previous objection to Claim 36 for having a typographical error is withdrawn by virtue of Applicant's amendment.

New - Claim Objections

7. Claims 32 and 33 are objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

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required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The parent claims are drawn to SEQ ID NO:1 or a portion thereof. The coding sequence is disclosed in the sequence listing; this does not include the complete complement. Thus, since the scope of Claims 32 and 33 are not within the scope of Claims 31 and 5, respectively, the instant claims do not further limit the subject matter of their parent claims appropriately.

8. Claims 34 and 37 are objected to under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim must depend from parent claims in the alternative. See M.P.E.P. § 608.01(n). The Examiner suggests ---claims 5, 9, 31, 32, or 33---.

Withdrawn - Claim Rejections - 35 U.S.C. § 112

9. Previous rejection of Claim 35 under 35 U.S.C. § 112, second paragraph, as being indefinite is withdrawn by virtue of Applicant's amendment.

10. Previous rejection of Claims 38-43 under 35 U.S.C. § 112, second paragraph, as being indefinite is withdrawn by virtue of Applicant's amendment.

11. Previous rejection of Claim 44 under 35 U.S.C. § 112, second paragraph, as being indefinite is withdrawn by virtue of Applicant's amendment.

12. Previous rejection of Claims 36-37 under 35 U.S.C. § 112, first paragraph, new matter, is withdrawn by virtue of Applicant's amending the claims to be limited to only *E. coli* and coryneform bacteria, which limitation has support in the specification as originally filed.

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13. Previous rejection of Claims 38-43 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicant's cancellation of said claims or by the amendment to closed language wherein functional language is not required for adequate written description since the claimed genus of polynucleotides is finite.

14. Previous rejection of Claims 38-43 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's cancellation of said claims or by the amendment to closed language wherein functional language is not required for adequate written description since the claimed genus of polynucleotides is finite.

15. Previous rejection of Claim 44 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's limiting the nature of overexpression in the claim.

Withdrawn - Claim Rejections - 35 U.S.C. § 102

16. Previous rejection of Claims 36-43 under 35 U.S.C. § 102(a) as being anticipated by Nakagawa *et al.* (EP 1108790) is withdrawn by virtue of Applicant's amendment limiting to 30 and 40 consecutive nucleotides, which fragments are supported in the priority document DE 10043337.5 filed on September 2, 2000, rendering EP 1108790 not prior art.

17. Previous rejection of Claims 38-43 under 35 U.S.C. § 102(a) as being anticipated by Pompejus *et al.* (WO 01/00843) is withdrawn by virtue of Applicant's amendment limiting to 30 and 40 consecutive nucleotides, which fragments are supported in the priority document DE 10043337.5 filed on September 2, 2000, rendering WO 01/00843 not prior art.

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Summary of Pending Issues

18. The following is a summary of the issues pending in the instant application:

- a) Claims 32 and 33 stand objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.
- b) Claims 34 and 37 stand objected to under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim must depend from parent claims in the alternative.

Conclusion

19. Claims 5, 9, 12, 31, 35, 36, 38, 39 and 44 are allowable. Claims 32-34 and 37 are objected to. Claims 13-30 remain withdrawn as non-elected inventions subject to rejoinder if amended to include all the limitations of the allowable products. Applicants must respond to the objections/rejections in each of the numbered sections in this Office action to be fully responsive in prosecution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M Kerr
Primary Examiner
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January 4, 2005